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|-----------------|-------------|----------------------|---------------------|------------------|
| 10/783,001      | 02/20/2004  | Christine Garcia     | Serie 6114          | 7142             |

7590 08/16/2005  
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EXAMINER

COTTON, ABIGAIL MANDA

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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1617

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/783,001

Applicant(s)

GARCIA, CHRISTINE

Examiner

Abigail M. Cotton

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 2/20/04, 6/8/04 and 6/30/05.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9-28 and 35 is/are pending in the application.  
4a) Of the above claim(s) 13 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 9-12, 14-28 and 35 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/20/04.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 9-28 and 35 are pending in the application as of the response received on June 30, 2005.

#### ***Election/Restrictions***

Applicant's election without traverse of claims 9-28 and 35 in the reply filed on June 30, 2005 is acknowledged.

Applicant's election without traverse of the species glycine is acknowledged. Claimed subject matter that does not read on this species is withdrawn from consideration as being drawn to non-elected subject matter. In particular, claim 13 is withdrawn from consideration for being drawn to a composition having a cyclic amino acid structure that does not read on the elected species of glycine.

This election requirement is deemed proper and made FINAL.

Accordingly, claims 9-28 and 35 are pending in the application, with claim 13 being withdrawn from consideration as being drawn to non-elected subject matter.

***Priority***

Applicant's claim of priority to FRANCE 0302162 02/21/2003 is acknowledged.

***Information Disclosure Statement***

The information disclosure statement filed on February 20, 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. In particular, a copy of the document "Preliminary Investigations on Some Potential Sources of Protected Methionine Derivatives for Ruminant Rations" was not provided.

***Claim Objections***

Claim 11 is objected to because the term "divalent metal salts" is spelled incorrectly as "divalentt metal salts." Appropriate correction is required.

Claim 35 is objected to because it has been misnumbered as claim 34. Applicant canceled previously presented claims 29-34 in the response filed on June 30, 2005.

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Accordingly, the numbering of newly added claims must start at 35. Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9-21 are rejected under 35 U.S.C. 101 because the claimed recitation of utilization of a composition, i.e. a "use" of a composition, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). Appropriate correction is required.

Claims 9-21 are being interpreted for the purposes of applying art rejections as being drawn to a method of slimming by administering the recited composition.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 9-21 are rejected under 35 U.S.C. 112, second paragraph, because while the claims provide for the utilization, i.e. "use" of a slimming agent in a formulation, the claims do not set forth any steps involved in the method/process, and thus it is unclear what method/process applicant they are intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. See for example *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1986.) Appropriate correction is required.

Claims 9-21 are being interpreted for the purposes of applying art rejections as being drawn to a method of slimming by administering the recited composition.

Claim 35 is rejected under 35 U.S.C. 112, second paragraph as being indefinite for reciting a method that "may be" used for slimming the human body. The phrase "may be" renders the claim indefinite because it is not clear to one of ordinary skill in the art whether the method is intended for the purposes of slimming the human body, or for purposes other than slimming. Accordingly, the metes and bounds of the subject matter being claimed cannot be ascertained. Appropriate correction and/or clarification is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-12, 14-23, 28 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication No. 2001/0002257 to Corrine Stolz, published May 31, 2001.

Stolz teaches a cosmetic composition of compounds of lipoamino acid structure and having germicidal activity (see paragraph 0001, in particular.)

Stolz exemplifies a cosmetic composition having 25% by weight of octanoylglycine with butylene glycol, glycerol and water (cosmetically acceptable medium), which is a composition that meets the limitations of claims 9-10, 12, 14-21 and 35 (see paragraphs 0077-0089, in particular.) Regarding claim 11, Stolz teaches that the active principle of the composition (such as octanoylglycine) can be present in the composition in the form of topically acceptable salts, and that the salt may be an alkali metal salt, among others (see paragraph 0015-0019, in particular.) Regarding claim 22, Stolz teaches that the composition is cosmetic, and thus is administered

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topically. Regarding claim 23, Stolz's teaching of the composition having 25% by weight of octanoylglycine meets the limitation of being administered in the range of from "about" 0.01% to "about" 10% by weight. Regarding claim 28, Stolz teaches that the composition comprises Sepicide®HB, which is a self-emulsifiable composition based on fatty alcohols as emulsifier (see paragraph 0066, in particular.)

Claims 9-12, 14-23, 28 and 35 are directed to methods of utilizing a composition as a slimming agent, and for slimming the human body. Stolz teaches the claimed composition for topically applying to the skin. Such topical application will inherently act as a slimming agent as the same composition is being taught. Furthermore, Applicant's "containing" (comprising) language does not exclude addition of ingredients, such as an extract, as for example in the Stolz reference. Accordingly, the teachings of Stolz anticipate the inventions of claims 9-12, 14-23, 28 and 35.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



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Claims 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application No. 2001/0002257 to Stolz, published May 31, 2001.

Stolz is applied as discussed for claims 9-12, 14-23, 28 and 35 above. Stolz does not teach providing a specific composition having the percent ranges recited in claims 24-25. Stolz does not specifically teach the exemplified composition having the cosmetic forms recited in claim 26, and does not teach a specific composition that is dispersed or impregnated onto textile or nonwoven materials as in claim 27.

Regarding claim 26, Stolz teaches that the composition can be in the form of an aqueous solution and a simple emulsion, among others. Accordingly, one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the recited cosmetic form of claim 26, because Stolz teaches that such forms are suitable for the cosmetic composition.

Regarding claims 24-25, Stolz teaches that the active principle can comprise from 0.001% to 6% by weight of the composition (see paragraph 0071, in particular), which overlaps with the ranges recited in the claims. Accordingly, one of ordinary skill in the art at the time the invention was made would have found it obvious to provide a weight percentage within the claimed ranges, because Stolz teaches that weight percentages within the claimed range are suitable for the cosmetic composition. Furthermore, one of ordinary skill in the art at the time the invention was made would

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have found it obvious to optimize the weigh percentage to provide a desired composition. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

Regarding claim 27, Stolz teaches that suitable formulations for the cosmetic composition can be in the form of wipes (see paragraph 0064, in particular), which are either textile or nonwoven materials. Accordingly, one of ordinary skill in the art at the time the invention was made would have found it obvious to disperse or impregnate the composition onto textile or nonwoven materials, because Stolz teaches that a wipe having the composition is a suitable formulation.

### ***Conclusion***

No claims are allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In particular, EP 0 415 598 1 to Peter Rex Brawn, published March 6, 1991, teaches a composition that promotes hair growth comprising N-acylated amino-acids.

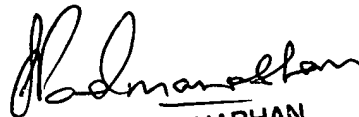
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abigail M. Cotton whose telephone number is (571) 272-8779. The examiner can normally be reached on 8:30-5:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMC

  
SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER